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IBM CORP (YA) C/O YEE & ASSOCIATES PC P.O. BOX 802333 DALLAS, TX 75380			EXAMINER REVAK, CHRISTOPHER A	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/631,066  
Filing Date: July 31, 2003  
Appellant(s): DODSON ET AL.

**MAILED**

**DEC 20 2007**

**Technology Center 2100**

\_\_\_\_\_  
Wayne Bailey  
Reg. No. 34,289  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed October 4, 2007 appealing from the Office action mailed June 28, 2007.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

6,311,275	JIN et al	10-2001
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6,957,276	BAHL et al	10-2005
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DROMS, "Dynamic Host Configuration Protocol", Network Working Group Request for  
Comments: 2131, March 1997, pg 1-45

DROMS et al, "Authentication for DHCP Messages", Network Working Group Request  
for Comments: 3118, June 2001, pg 1-17

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 15-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 15-20 recite of a computer readable medium that is directed toward non-statutory subject. According to the applicant's specification, beginning on page 17, line 33 through page 18, line 5, various examples of media is given, however transmission media is recited as a particular type of media that is non-statutory. The examiner notes that the applicant's specification is written in a manner which separates recordable media versus transmission media and the examiner suggests amending claim 15 to recite that the computer readable medium is either "recording medium" or a "storage medium".

As per claim 21, the claim recites of a computer program product which is not stored on a computer readable storage/recording medium. The claims are software alone, and of itself and should be amended to indicate that the computer program product is stored on "computer readable storage/recording medium."

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1,3,4,5,11,12,15, and 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Jin et al, U.S. Patent 6,311,275.

As per claim 1, Jin et al teaches of a method in a data processing system for providing addresses to clients, the method comprising receiving a request from a client

for an address; determining whether authentication information is present in the request; performing an authentication process using the authentication information if the authentication information is presenting the request; determining whether the authentication information is authenticated; and responsive to the authentication information being authenticated, providing a privileged address to the client and responsive to the authentication information not being authenticated, providing a dummy (standard) address to the client (col. 4, line 44 through col. 5, line 10 and col. 5, lines 11-24).

As per claim 3, it is taught by Jin et al wherein the address is an Internet Protocol address (col. 5, lines 1-3).

As per claim 4, it is disclosed by Jin et al wherein the authentication information is a pass phrase (col. 4, lines 53-54).

As per claim 5, Jin et al teaches wherein the authentication process determines whether the pass phrase is a valid pass phrase (col. 4, lines 53-54).

As per claim 11, it is taught by Jin et al wherein the authentication information is a pass phrase (col. 4, lines 53-54).

As per claim 12, it is disclosed by Jin et al wherein the authentication process determines whether the pass phrase is a valid pass phrase (col. 4, lines 53-54).

As per claim 15, it is taught by Jin et al of a computer program product in a computer readable medium for providing addresses to clients, the computer program product comprising first instructions for receiving a request from a client for an address; second instructions for determining whether authentication information is present in the

request; third instructions for performing an authentication process using the authentication information if the authentication information is presenting the request; fourth instructions for determining whether the authentication information is authenticated; and fifth instructions, responsive to the authentication information being authenticated, for providing a privileged address to the client and responsive to the authentication information not being authenticated, providing a dummy (standard) address to the client (col. 4, line 44 through col. 5, line 10 and col. 5, lines 11-24).

As per claim 17, Jin et al teaches wherein the address is an Internet Protocol address (col. 5, lines 1-3).

As per claim 18, Jin et al discloses wherein the authentication information is a pass phrase (col. 4, lines 53-54):

As per claim 19, it is taught by Jin et al wherein the authentication process determines whether the pass phrase is a valid pass phrase (col. 4, lines 53-54).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6, 13, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jin et al, U.S. Patent 6,311,275.

The teachings of Jin et al disclose of using password information in order to validate a user prior to assignment of a privileged address, however the teachings of Jin et al fail to disclose of using and validation of a digital certificate and which includes information indicating whether the certificate is from a trusted authority. The examiner hereby takes official notice that using and validation of a digital certificate and which includes information indicating whether the certificate is from a trusted authority is notoriously well known to one of ordinary skill in the art. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have been motivated to apply the use of digital certificates as an alternative source of validation. It is notoriously well known that digital certificates are issued from trusted third parties wherein they can be validated and contain unique information as to who issued the certificate, the user it is assigned to, the user's public key, and validation periods that the certificate is valid for a certain length of time. It is obvious that the teachings of Jin et al could have been altered in order to include the use of digital certificates wherein the digital certificates would contain additional unique information that would more appropriately validate the user and issuer of the certificate.

7. Claims 7,14, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Droms, RFC 2131 in view of Droms et al, RFC 3118.

As per claims 7,14, and 21, it is taught by Droms, RFC 2131 of a receiving a request from a client for an address; determining whether information is present in the request; performing a verification process using the information if the information is



present in the request; determining whether the information is verified; responsive to the information being verified, providing an address to the client; responsive to the information not being verified, denying the request receiving the address by the client, wherein the address received by the client is included in an offer from a server that performed the verification process; determining, by the client, whether the offer is valid; and responsive to the offer being valid, accepting the offer by the client (section 3.1, page 13 and steps 3-5 on pages 15-16). The teachings of Droms, RFC 2131 fail to disclose of using authentication information to be authenticate the DHCP communications between the server and the client. In an expanded teaching of Droms, RFC 2131, Droms et al, RFC 3118 discloses that authentication occurs between a server and client in order to complete the DHCP process (page 4, section 1.4, step 5; page 6, section 5.3; and page 7, section 5.5.1). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have been motivated to use authentication measures in order to validate the assignment of an IP address. The teachings of Droms et al, RFC 3118 recite of motivation for use of authentication by disclosing that the allocation of addresses is limited to authorized hosts and of the need for authenticating the source and content of DHCP messages (abstract) and it is obvious that the teachings of Droms, FRC 2131 would have been made more secure by use of authentication of the host and server as disclosed by Droms et al, RFC 3118.

8. Claims 8,9, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jin et al, U.S. Patent 6,311,275 in view of Bahl et al, U.S. Patent 6,957,276.

As per claim 8, it is disclosed by Jin et al of a data processing system for providing addresses to clients, the data processing system comprising receiving means for receiving a request from a client for an address; first determining means for determining whether authentication information is present in the request; performing means for performing an authentication process using the authentication information if the authentication information is presenting the request; second determining means for determining whether the authentication information is authenticated; and providing means, responsive to the authentication information being authenticated, for providing a privileged address to the client (col. 4, line 44 through col. 5, line 10 and col. 5, lines 22-24). The teachings of Jin et al fail to disclose that the privileged address is a static IP address that is identical to a previous address that was provided to a client. It is taught by Bahl et al that the privileged address is a static IP address that is identical to a previous address that was provided to a client (col. 2, lines 57 through col. 3, line 7). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have been motivated to reclaim static addresses. The teachings of Bahl et al discloses of motivation for static IP address being is identical to a previous address that was provided to a client by reciting of an automated approach so that the assignment of static addresses can be done in a centralized manner so that an administrator doesn't have to physically visit each machine to make the changes (col. 2, lines 12-17 & 57-63). It is obvious that the teachings of Jin et al would have found the teachings of Bahl et al beneficial so that the same static addresses can be assigned in a centralized manner.

As per claim 9, Jin et al teaches of further comprising providing means, responsive to the authentication information not being authenticated, for providing a standard address to the client (col. 5, lines 11-21).

As per claim 22, Jin et al discloses of a data processing system for providing addresses to clients, the data processing system comprising a bus system; a memory connected to the bus system, wherein the memory includes a set of instructions; a communications adaptor connected to the bus system; and a processor unit connected to the bus system, wherein the processor unit-executes the set of instructions to receive a request from a client for an address; determine whether authentication information is present in the request; perform an authentication process using the authentication information if the authentication information is presenting the request; determine whether the authentication information is authenticated; and provide a privileged address to the client in response to the authentication information being authenticated (col. 4, line 44 through col. 5, line 10 and col. 5, lines 22-24).

## **(10) Response to Argument**

### **A.1 Claims 15-20**

The Appellant argues that a "computer readable medium encoded with a data structure" defines a structural and functional interrelationship.

The examiner disagrees, the examiner has never indicated that the claims fail to define a structural and functional interrelationship, but rather the claims fail to disclose of statutory subject matter by claiming transmission media which is not statutory subject

matter. The Interim Guidelines for Examiner of Patent Applications for the Patent Subject Matter Eligibility published in the Official Gazette on November 22, 2005, Section Annex IV (c), indicated "signal claims are ineligible for patent prosecution because they do not fall within any of the four statutory classes of Section 101". In the instant application, the examiner refers to the applicant's specification, beginning on page 17, line 33 through page 18, line 5, various examples of media is given, however transmission media is recited as a particular type of media that is non-statutory. The readable medium includes transmission media with only instructions which is just software alone and of itself and fail to make the claims statutory.

#### A.2 Claim 21

The Appellant argues that the claim is statutory subject matter is claimed, since a "computer program product in a data processing system" is claimed and recites of a specific apparatus.

The examiner respectfully disagrees, by stating that the product is "in" a data processing system does not make the claimed subject matter statutory. What constitutes being "in" the data processing system? The examiner has indicated that the claims fail to disclose that the computer program product is not "stored" in the data processing system and the claims merely recite of just software. The body of the claims recite of multiple instructions which is further proof that the claims are directed to just software.

B.1 Claims 1,4,5,11,12, and 15

The appellant indicates that “responsive to the authentication information being authenticated, providing a privileged address to the client” is not taught by Jin et al and the teachings fail to disclose of a “privileged address” by Jin whereby Jin only teaches of a “genuine address” which is not the same.

The examiner asks the question, what is a “privileged address” as claimed by the applicant? The Appellant has failed to define what a “privileged address” is and just argues the fact that the term “privileged address” is not taught by Jin, then the examiner has failed to meet the claim limitations. In review of the Appellant's specification, there is no definition provided as to what a “privileged address” is, nor has the Appellant described in their remarks what a “privileged address” is. The examiner is interpreting a “privileged address” to be an assigned address that is specific to a certain condition being met, and in regards to the teachings of Jin, it is an address that is assigned to an authenticated and authorized user, see column 5, lines 22-24. The Appellant has failed to specifically address the limitation and by merely arguing that since an identical term is not claimed, then it is not taught in the prior art to which the examiner disagrees. The genuine address of Jin et al is assigned to a user once they have been authenticated and determined to be authorized which is the same as a “responsive to the authentication information being authenticated, providing a privileged address to the client”.

The Appellant argues that Jin et al fails to teach “responsive to the authentication information not being authenticated, providing a standard address to the client”. And

that Jin et al teaches the opposite, Jin et al only teaches of "the user has in fact been authorized".

The examiner disagrees with the Appellant's remarks. As indicated by the Appellant, Jin et al discloses "If the AAA Server 4 authorizes the user, but does not assign an IP address, then the SSG server 3 can log the user on with a dummy temporary IP address", see column 5, lines 11-13. The Appellant fails to distinguish between authorization and authentication and although the two are used interchangeably, they are not the same process. A broad interpretation of authentication proves the identity of an entity and authorization establishes the right and entitlement of performing the function or task. Jin et al discloses that "if the user authentication check is successful, the AAA Server 4 may assign an IP address to the user and include this IP address in the access-reply packet. The SSG server 3 then checks for an IP address in the access-reply packet. If the SSG Server 3 finds an IP address, then the SSG Server 3 can log the user on with the IP address provided by the AAA Server 4, and then forward the access-reply packet on to the NAS 2 immediately at step 206. Once the access-reply packet is received by the NAS 2, it may then log the user on as well, and the user session can begin. If the AAA Server 4 authorizes the user *but does not assign an IP address*, then the SSG Server 3 *can log the user on with a dummy temporary IP address*. It then assigns the user an identification number that it inserts into the access-reply packet before forwarding the access-reply packet to the NAS 2 at step 206." See column 4, line 67 through column 5, line 16. The Appellant argues that the user is in fact "authorized" which is the examiner agrees, but

"authorization" is not claimed by the Appellant and "authorization" is not the same as "authentication" rendering the Appellant's remarks moot.

#### B.2 Claim 3

The Appellant argues that the examiner has failed to show that the prior art teachings of Jin et al fail to disclose of "wherein the privileged address is a static Internet Protocol address that is identical to a previous address that was previously provided to the client in response to a previously received request from the client."

The examiner agrees with the Appellant, however this rejection was a typographical error by the examiner and similar limitations were rejected in view of Bahl et al with regards to dependent claim 8,9, and 22. Please refer to section E.1 whereby the examiner addresses the rejection of the claimed limitations.

#### C.1 Claims 6,13, and 20

The Appellant argues that an allegation of "notoriously well known" is not a valid basis for 35 USC 103 and that improper hindsight has been applied.

The examiner disagrees with the Appellant and has incorrectly addressed the examiner's rejection. The original rejection was applied in the non-final office action and the Appellant failed to address the rejection until the filing of the Appeal Brief. The examiner would like to refer the Appellant to the examiner's rejection wherein official notice has been taken and the Appellant has failed to seasonably challenge the examiner's use of official notice and the Appellant's remarks constitute an improper reply. As per MPEP 2144.03, the Appellant has failed to adequately traverse the

examiner's use of official notice by challenging the examiner to provide documentary evidence to support the examiner's use of official notice. By merely arguing that something is not "notoriously well known" is in adequate response on behalf of the Appellant. The examiner's use of official notice was indicated as being directed to validation of a digital certificate and which includes information indicating whether the certificate is from a trusted authority is notoriously well known to one of ordinary skill in the art. It is notoriously well known that digital certificates are issued from trusted third parties wherein they can be validated and contain unique information as to who issued the certificate, the user it is assigned to, the user's public key, and validation periods that the certificate is valid for a certain length of time. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

#### D.1 Claims 7, 14, and 21

The Appellant argues that Droms RFC 3118 fails to teach "performing a verification process using the authentication information if the authentication information is present in the request", and "**responsive to** the authentication information being



verified, providing an address to the client" and the teachings of Droms only disclose of "message authentication" which is different from entity verification.

The examiner disagrees with the Appellant's assertion and is confused by the Appellant's statement that Droms et al RFC 3118 only discloses "message authentication" which is different from "entity authentication" when the claims fail to specify "who" or "what" is being authenticated. The claim only recites "determining whether authentication information is present in the request"; "performing a verification process using the authentication information"; and latter recites of "determining, by the client, whether the office is authentic". Nowhere in the claims does it mention that entity authentication is performed, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., entity authentication) is not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir.1993). Although claim 7 is argued, the examiner notes that these limitations are not recited in both independent claims 14 and 21. Droms et al disclose providing authentication of the source and contents of DHCP messages, see abstract, page 1. Furthermore, Droms et al teaches that the client requests authentication in a DHCP discover message and the authentication information that is generated by the source as a message authentication code to provide message authentication and entity authentication, see section 5, page 4. Authentication information is clearly present in the request of Droms et al and it is verified by the client. The verification by the

receiver, or client, determines whether the DHCP message is to be discarded or accepted and then chooses one of the offered configurations, which includes an address, see section 1.4, page 2; section 5.3, page 6; and section 5.5.1, page 7.

The Appellant additionally argues that Droms fails to disclose of "server-side verification process that is conditionally performed".

The examiner disagrees with the Appellant's remarks, no where in claim 7 is the limitation "server-side verification process that is conditionally performed" claimed. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., server-side verification process that is conditionally performed) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir.1993). Although claim 7 is argued, the examiner notes that these limitations are not recited in both independent claims 14 and 21

#### E.1 Claims 8,9, and 22

The Appellant argues that Bahl et al fails to disclose "providing a static IP address to a client responsive to authentication information being authenticated".

The examiner disagrees with the Appellant's assertion, the Appellant has improperly addressed the examiner's rejection, Jin et al is relied upon for disclosing providing a privileged address to a client responsive to authentication information being authenticated, see column 5, lines 22-24. The teachings of Jin et al were

acknowledged by the examiner to not teach the limitation of the "privileged address being a static IP address" and the teachings of Bahl et al are relied upon for disclosing this limitation, see Bahl et al, column 1, line 57 through column 3, line 7. The motivation of Bahl et al's static IP address being identical to a previous address that was provided to a client by reciting of an automated approach so that the assignment of static addresses can be done in a centralized manner so that an administrator doesn't have to physically visit each machine to make the changes, column 2, lines 12-17 & 57-63. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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Primary Examiner AU 2131

CHRISTOPHER REVAK  
PRIMARY EXAMINER



Conferees:

/GBJ/

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